

### **REMARKS/ARGUMENTS**

Applicant's undersigned attorney thanks the Examiner for his comments. Applicant respectfully requests reconsideration of this patent application, particularly in view of the above amendments and the following remarks.

#### **Amendment to the Specification**

Applicant has amended the specification at page 9, line 11, to include the feature claimed in the original Claims 5 and 6. This amendment to the specification adds no new matter to this patent application.

#### **Amendment to the Drawings**

Applicant has amended Fig. 1 to include the previously omitted element 196. The omitted element appears in the original Claims 5 and 6. This amendment to the drawings adds no new matter to this patent application.

#### **Amendment to the Claims**

Claims 1-28 have been examined with claims 1-28 being rejected.

Applicant has amended Claims 1 and 10 to clarify that the frame assembly is mounted to upright bars of a motorcycle. Support for this amendment is

Appln. Serial No.: 10/633,736  
Reply to Office Action dated 10 November 2004

found on page 7, lines 3-5, of the specification. In addition, Claim 1 has been amended to add the limitation that the top plate is a functional luggage carrier and the at least one other top plate is a decorative motorcycle accessory. This limitation was incorporated from the original Claim 3, and the original Claim 3 has been canceled. Claim 1 has also been amended to incorporate the limitations from the original Claim 2, and the original Claim 2 has been canceled.

Applicant has amended Claims 1 and 21 to clarify that the cover plate and the lock plate are positioned on opposite sides of the upright bars. Support for this amendment is found on page 7, first full paragraph, of the specification. Applicant has also amended Claims 12 and 25 to clarify that the lock plate and the at least one clamping block are positioned on opposite sides of the upright bars. Support for this amendment is found on page 11, second full paragraph, of the specification.

Applicant has amended Claims 5-8, 10, 12, 14, 16, 18, 20, 21, 23, and 25 for clarification purposes and/or to correct typographical and antecedent basis errors.

Applicant has cancelled Claims 2-4, 13, 15 and 27.

These amendments to the Claims add no new matter to this patent application.

**Claim Rejections - 35 U.S.C. §102(e)**

Claims 1-14, 17, 21, 25, 27 and 28 have been rejected under 35 U.S.C. §102(e) as being unpatentable over Petersen, U.S. Patent 6,659,547, (the Petersen Patent). In view of the above amendments and the following remarks, this rejection is respectfully traversed.

The Petersen Patent discloses a cargo carrier, which is a generally flat plate, clamped to a horizontal subframe of a motorcycle. The Petersen Patent further discloses a backrest assembly comprising a carrier assembly and a back plate assembly that is pivotally attached to the carrier assembly. The carrier assembly, as disclosed in the Petersen Patent, can be mounted directly to the subframe or to the cargo carrier. The Petersen Patent teaches no connection between the carrier assembly and the cargo carrier when the carrier assembly is mounted directly onto the subframe. Instead, the carrier assembly is independently attached to the subframe at a different location. In the other alternative taught by the Petersen Patent, the cargo carrier is mounted to the subframe first, and the cargo assembly is mounted on top of the cargo carrier.

Applicant's invention, as claimed in amended independent Claims 1, 10, 21 and 25, requires a frame assembly mounted to upright bars of a motorcycle and an interchangeable top plate removably attached to the frame assembly; the top plate

being interchangeable with another top plate having a different configuration. Furthermore, Applicant's invention, as claimed in amended independent Claim 1, requires the top plate to be a functional luggage carrier and the at least one other top plate to be a decorative motorcycle accessory. Moreover, Applicant's invention, as claimed in amended independent Claims 21 and 25, requires a frame assembly to be comprised of a lock plate and a cover plate, or a lock plate and at least one clamping block, positioned on opposite sides of the upright bars.

The Petersen Patent does not teach or suggest a frame assembly mounted to upright bars of a motorcycle and an interchangeable top plate removably attached to the frame assembly. The Petersen Patent does not teach or suggest a top plate interchangeable with another top plate having a different configuration. The Petersen Patent does not teach or suggest that the top plate is a functional luggage carrier and the at least one other top plate is a decorative motorcycle accessory. Instead, the Petersen Patent teaches a single cargo carrier attached directly to a generally horizontal subframe of a motorcycle, and a backrest assembly attached on top of the cargo carrier, which, in effect, prevents the cargo carrier from being freely and easily removable and/or interchangeable, as required by Applicant's invention. Moreover, the Petersen Patent does not disclose or suggest a frame assembly comprising a lock plate and a cover plate, or a lock plate and at least one clamping

block, where the lock plate and the cover plate or at least one clamping block are positioned on opposite sides of the upright bars of a motorcycle. The Petersen Patent, therefore, does not teach each and every element or limitation of Applicant's amended claims as required in 35 U.S.C. §102.

For at least the reasons presented above, Applicant respectfully submits that amended Claims 1, 10, 21 and 25 are not anticipated by the Petersen Patent. Because the remaining claims depend from either Claim 1, 10, 21 or 25, these claims are also not anticipated by the Petersen Patent. Applicant believes that the above amendment and comments overcome the rejection of Claims 1, 5-12,14, 16-26 and 28-29, and Applicant respectfully requests withdrawal of this rejection.

#### **Claim Rejections - 35 U.S.C. §103(a)**

Claims 1-19 and 21-28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Petersen in view of Dreiling, U.S. Patent 5,845,830, ( the Dreiling Patent). This rejection is respectfully traversed.

The Dreiling Patent does not teach or suggest a motorcycle luggage rack system suitable for carrying luggage or other heavy objects on a motorcycle. The Dreiling Patent discloses a seat assembly attachable to children' bicycles or tricycles suitable for carrying lightweight objects, such as dolls or the like. Moreover, the

Dreiling Patent suggests that the clamp (86) be comprised of a substantially rigid plastic material (at Column 6, lines 24-25). Thus, upon reading of the Dreiling Patent, a person of ordinary skill in the art would not be motivated to combine the Petersen Patent and the Dreiling Patent in contemplation of the present invention. Therefore, Applicant urges that a person having ordinary skill in the art would not be lead to the present invention by a reading of the above mentioned Patents.

Even if we assume that a person of ordinary skill in the art would be motivated to combine the Petersen Patent and the Dreiling Patent, the combination of those two references would not achieve the Applicant's claimed motorcycle luggage rack. Even in combination, the Petersen Patent and the Dreiling Patent do not teach or suggest a motorcycle luggage rack having an interchangeable top plate, removably attached to a frame assembly, wherein the top plate is interchangeable with another top plate having a different configuration, particularly both a functional luggage rack and a decorative motorcycle accessory. Moreover, the subject Patents do not teach or suggest a motorcycle luggage rack having a cover plate and a lock plate, or a lock plate and at least one clamping block, on opposite sides of upright bars of a motorcycle. Nor would the present invention be obvious in view of the Non-Patent Literature cited by the Examiner since the luggage racks disclosed on the website are unitary luggage racks having no removable and/or interchangeable top plates.

The Examiner suggests that it would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the device taught by the Petersen Patent in view of the Dreiling Patent to achieve the present invention. However, since such modification would change the principle of operation of the device taught by Petersen Patent and make it unsatisfactory for its intended purpose, the teachings of the subject Patents are not sufficient to render the present invention *prima facie* obvious. In the Petersen Patent, as unmodified, the cargo carrier (i.e., a generally flat plate) is clamped directly to a horizontally oriented subframe of a motorcycle, and the back rest assembly is mounted on top of the cargo carrier. In other words, the cargo carrier provides for attachment of and support for the back rest assembly, i.e., the upright members. The suggested modification, on the other hand, would require that an upright member provide support and a point of attachment for a cargo carrier, which is exactly opposite to the requirement of the Petersen Patent. Such modification would not only change the principle of operation of the device taught by the Petersen Patent, but would also render it unsatisfactory for its intended purpose. Thus, Applicant urges that the present invention is not obvious in view of the Petersen Patent and further in view of the Dreiling Patent.

Claims 20 and 29 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Petersen and further in view of Holtzclaw, U.S. Patent Des.

Appln. Serial No.: 10/633,736  
Reply to Office Action dated 10 November 2004

325,820 (the Holtzclaw Patent). This rejection is respectfully traversed.

The Holtzclaw Patent is in the filed of firearms, and Applicant's invention is in the field of motorcycle luggage racks. Therefore, the Holtzclaw Patent is clearly not in the field of Applicant's invention. Furthermore, because firearms and motorcycle luggage racks are very distinct and different categories of goods, having very distinct and different shapes, sizes and utilities, a person of ordinary skill in the art in the Applicant's filed of invention could not possibly be aware that a similar problem exists in the area of firearms, i.e., a need for a particular cover, or that a suitable cover design for a motorcycle luggage rack could be obtained upon inquiry into the field of firearms. Thus, the Holtzclaw Patent is not reasonably pertinent to the problem with which Applicant was concerned because a person of ordinary skill in the art faced with the same problem, i.e., designing a cover for a motorcycle rack, would not be motivated or expected to inquire into covers for firearms. Consequently, Applicant urges that the Holtzlaw Patent may not be relied on in making a §103(a) rejection, because the Holtzlaw Patent is neither in the field of Applicant's invention nor reasonably pertinent to the problem with which Applicant was concerned.

Thus, Applicant urges that Holtzclaw is not an analogous art, and Applicant respectfully requests withdrawal of this rejection.



Appln. Serial No.: 10/633,736  
Reply to Office Action dated 10 November 2004

### **Request for an Interview**

Should the preceding amendments and remarks not result in allowance of the subject U.S. patent application, Applicant's undersigned attorney kindly requests that the Examiner contact Anna Swietek via telephone at 847.490.1400, in an effort to expedite examination of this Patent Application.

### **Conclusion**

Applicant intends to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicant has not addressed in this response, Applicant urges the Examiner to contact the undersigned.

Applicant sincerely believes that this patent application is now in condition for allowance and, thus, respectfully requests early allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'KDEIK'.

Kevin D. Erickson  
Registration No. 38,736

Pauley Petersen & Erickson  
2800 West Higgins Road; Suite 365  
Hoffman Estates, Illinois 60195  
TEL (847) 490-1400  
FAX (847) 490-1403

Appln. Serial No.: 10/633,736  
Reply to Office Action dated 10 November 2004

**Amendments to the Drawings:**

The attached Replacement Sheet of drawings include changes to Fig. 1. This Replacement Sheet, which includes Fig. 1, replaces the original sheet including Fig.

1. In Fig. 1, previously omitted element 196 has been added.

Attachment:            Replacement Sheet  
                             Annotated Sheet Showing Changes

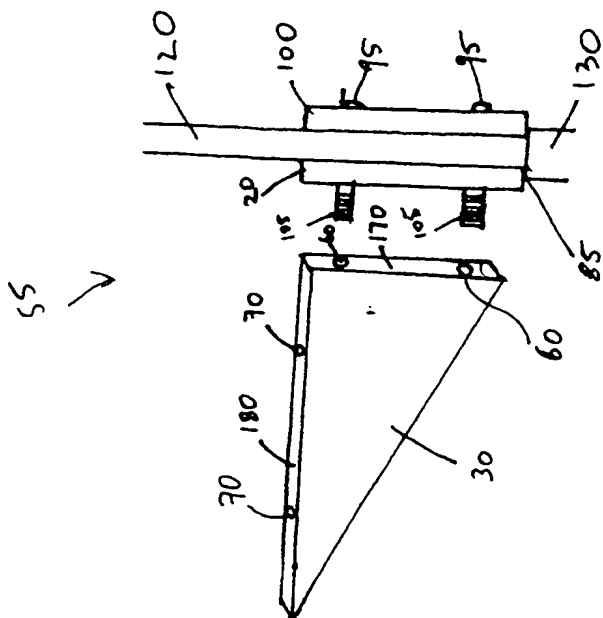


Fig. 3

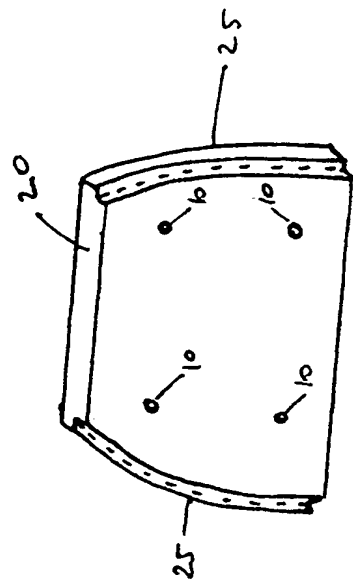


Fig. 4

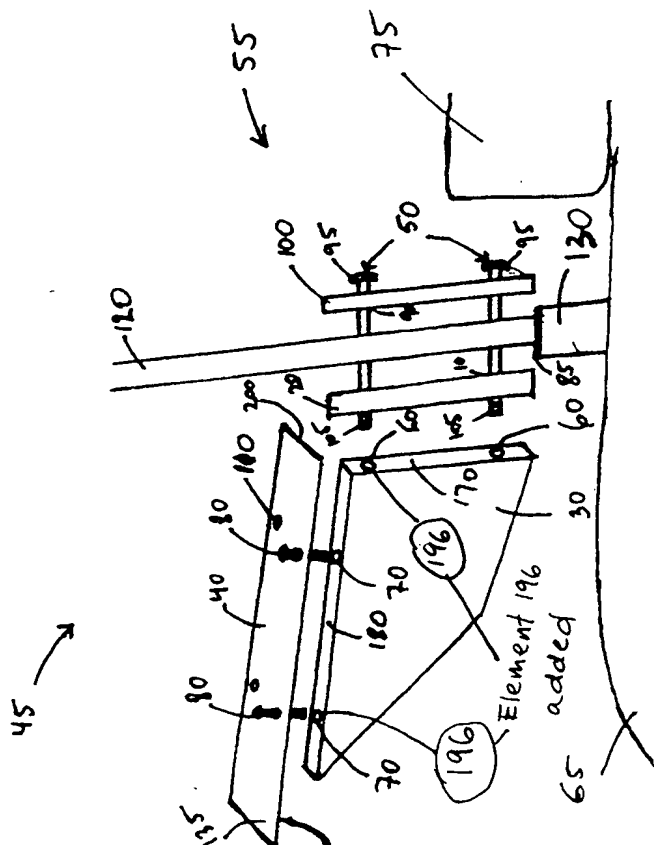


Fig. 1

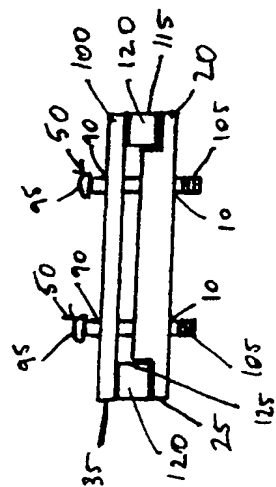


Fig. 2